

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

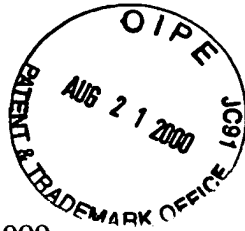
In re application of:

GERARD *et al.*

Appl. No. 09/438,358

Filed: November 12, 1999

For: **Compositions and Methods for
Recombinational Cloning of
Nucleic Acid Molecules**



Art Unit: 1636

Examiner: Leffers Jr., G.

Atty. Docket: 0942.4640001/RWE/BID

#6
H. G. J.
8/28/00

Reply To Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated June 20, 2000, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group III, represented by claims 14-51, only as drawn to *in vitro* methods for recombinational cloning. This election is made without traverse, and without prejudice to or disclaimer of the other claims or inventions disclosed.

In reply to the first requirement for election of species (characterized as Group III, species I in the Office Action), Applicants hereby elect claim 25 (S20 ribosomal protein), without traverse and without prejudice to or disclaimer of the other claims or inventions disclosed.

In reply to the second requirement for election of species (characterized as Group III, species II in the Office Action), Applicants hereby elect claim 46 (S20 ribosomal protein), without traverse and without prejudice to or disclaimer of the other claims or inventions disclosed.

In reply to the third requirement for election of species (characterized as Group III, species III in the Office Action), Applicants hereby elect a prokaryotic vector from claim 36, and *Escherichia* spp. from claim 38. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. This election is made **with** traverse. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants respectfully assert that the bacterial genera recited in claim 38 are closely related with regard to the ability of a given prokaryotic vector to propagate and/or replicate in host cells of the recited genera. As such, a search of one genus of bacteria is likely to encompass subject matter pertinent to the patentability of all of the recited genera. Moreover, the Examiner has not satisfied the second requirement set forth in MPEP § 803, *i.e.* the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction to one of these alleged species was not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both is required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, reconsideration and withdrawal of the requirement for election of one the bacterial genera recited in claim 38, grouped by the Examiner into Group III, species III, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Agent for Applicants
Registration No. 42,473

Date: August 18, 2000

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600

P:\USERS\BRIAND\0942\4640001\082100.reply.rrq.wpd